UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,801	07/31/2006	Marie-Claire Grosjean-Cournoyer	P/4976-36	5300

2352 7590 10/06/2011

OSTROLENK FABER LLP
1180 AVENUE OF THE AMERICAS
NEW YORK, NY 10036-8403

EXAMINER	
PAK, JOHN D	

ART UNIT	PAPER NUMBER
1616	

MAIL DATE	DELIVERY MODE
10/06/2011	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	**Application No.** 10/587,801	**Applicant(s)** GROSJEAN-COURNOYER ET AL.
	Examiner JOHN PAK	**Art Unit** 1616

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 28 July 2011 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☒ The period for reply expires *3* months from the mailing date of the final rejection.
   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: *24-25 (for being dependent on a rejected claim, see further comments below)*.
   Claim(s) rejected: *1-10,19,20,22 and 23*.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/John Pak/
Primary Examiner, Art Unit 1616

Continuation of 5. Applicant's reply has overcome the following rejection(s): obviousness type double patenting rejections over U.S. Patents 7,776,892 and 7,786,148 .

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's arguments are substantially similar to those that were already made in previous responses and the arguments have already been answered in prior Office actions. Applicant continues to argue that disclosure of Colby method in other U.S. patents should be sufficient evidence of its validity as a method for showing unexpected synergism. The Examiner has maintained that the Colby method is unreliable and has provided many reasons why this is so. See for example the previous Office action of 4/28/2011, pages 7-10. Even applicant's own data shows that Colby method does not work -- see pages 6-7 of the 4/28/2011 Office action. The fact that something is part of a patent specification disclosure does not mean that that something was relied on for patentability determination. For example, if this case were to be allowed at some later time, it would not be because the Examiner relied on the Colby method. Applicants are free to insert any method of evaluating data in their specification, even wrong methods, but if the data is good anyway and the case is allowed, it does not necessarily follow that such wrong method was relied on for patentability determination. For the reasons of record, claims 1-10, 19, 20, 22, and 23 stand rejected. Claims 24 and 25 have been amended to a specific combination of the two tested compounds at a specific ratio as set forth in specification Example 1 (pages 12-13). Based on the additive method of evaluating the mixture data, amended claims 24-25 are not included in the obviousness ground of rejection, supra, because the evidence of nonobviousness outweighs the evidence of obviousness with respect to these claims -- but because claims 24-25 are dependent on a rejected claim, they must be objected to.

Applicant is advised that the terminal disclaimer of 7/28/2011 has been accepted and recorded.